

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Re: Appeal to the Board of Patent Appeals and Interferences

Appellants: Pacheco eta I.)	Examiner: Barbara J. Musser
)	
Serial Number: 10/743,245)	Group Art Unit: 1733
)	
Filed: December 22, 2003)	Customer Number: 22827
)	
Confirmation No.: 6968)	Deposit Account: 04-1403
)	
Title: "Extensible and Stretch Laminates and Method of Making Same)	Attorney Docket No. KCX-1291 (20006)
)	

1. ☐ **NOTICE OF APPEAL:** Pursuant to 37 CFR 41.31, Applicant hereby appeals to the Board of Appeals from the decision dated _ of the Examiner twice/finally rejecting claims _.
2. ☐ **BRIEF** on appeal in this application pursuant to 37 CFR 41.37 is transmitted herewith (1 copy).
3. ☐ An **ORAL HEARING** is respectfully requested under 37 CFR 41.47 (due within two months after Examiner's Answer).
4. ☒ Reply Brief under 37 CFR 41.41(b) is transmitted herewith (1 copy).
5. ☐ "Small entity" verified statement filed: [] herewith [] previously.

6. **FEE CALCULATION:**

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PETITION is hereby made to extend the original due date of February 22, 2009, hereby made for an extension to cover the date this response is filed for which the requisite fee is enclosed (1 month \$130; 2 months \$490; 3 months \$1,110; 4 months \$1,730, 5 months \$2,350

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If "small entity" verified statement filed ☐ previously,
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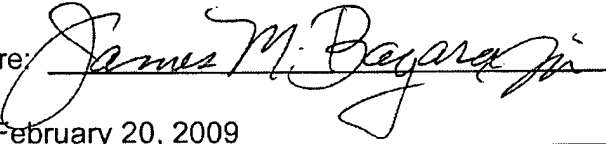
TOTAL FEE ENCLOSED: \$ 0.00

- ☐ Fee enclosed.
- ☐ Charge fee to our Deposit Account/Order Nos. in the heading hereof (for which purpose one additional copy of this sheet is attached)
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- ☐ Fee NOT required since paid in prior appeal in which the Board of Appeals did not render a decision on the merits.

The Commissioner is hereby authorized to charge any fee specifically authorized hereafter, or any fees in addition to the fee(s) filed, or asserted to be filed, or which should have been filed herewith or concerning any paper filed hereafter, and which may be required under Rules 16-18 (deficiency only) now or hereafter relative to this application and the resulting official document under Rule 20, or credit any overpayment, to our Account No. shown in the heading hereof. This statement does not authorize charge of the issue fee in this case.

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By: James M. Bagarazzi Reg. No: 29,609Signature: Date: February 20, 2009

I hereby certify that this correspondence and all attachments and any fee(s) are being electronically transmitted via the internet to the U.S. Patent and Trademark Office using the Electronic Patent Filing System on February 20, 2009.

Heidi M. Lewis

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(Signature of person transmitting documents)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Re: Appeal to the Board of Patent Appeals and Interferences

Appellants:)	Attorney Ref.: KCX-1291 (20006)
JOSE MALDONADO PACHECO et al.)	
)	Examiner: Barbara J. Musser
Serial No: 10/743,245)	
)	Group Art Unit: 1733
Filed: 12/22/2003)	
)	Deposit Account No: 04-1403
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Title: EXTENSIBLE AND STRETCH LAMINATES AND METHOD OF MAKING SAME

APPELLANTS' REPLY BRIEF

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellants hereby submit the Reply Brief responsive to the Examiner's Answer
mailed on December 22, 2008, in accordance with 37 CFR § 41.41 for the subject
application.

7. REPLY TO EXAMINER'S RESPONSE TO APPELLANTS' ARGUMENT:

A. **Claims 1 – 11 and 13 – 20 are patentable under 35 U.S.C. § 103(a) over Dobrin et al in view of Weber et al and Boger et al**

Lines 16-17 on page 13 of the Examiner's Answer states (emphasis added):

This is a simple combination of **known prior art elements** according to known methods to yield predictable results.

This conclusory statement is an example of a basic deficiency that runs through the Final Office Action and the Examiner's Answer. Each of them in its own way has lost sight of the fact that Section 103(a) entitles appellants' claims to be judged by whether the invention **as a whole** is obvious in view of the prior art. Yet, each of the Final Office Action and the Examiner's Amendment takes the approach that if each element of appellants' claims can separately be shown to be known to a person of ordinary skill (regardless of the context in which the element is used), then appellants' claim containing all of those individual elements will be shown to have been unpatentable. However, such a result is not sanctioned by the KSR decision of the Supreme Court. Moreover, the KSR decision cannot be shown to have eliminated the requirement of demonstrating that each of appellants' claims **as a whole** must be shown to be obvious to the person of ordinary skill. Appellants respectfully submit that this requirement has not been demonstrated for any of the claims on appeal.

Lines 15-17 on page 7 of the Examiner's Answer make the following statement:

In general, a film moving from one location to another is considered to be under tension unless specifically described as not under tension since it is tension in the longitudinal direction that moves the web.

Respectfully, the above statement is factually erroneous. A web can be moved by passing it between the nips of powered rollers. If the downstream rollers are rotating at the same speed as the upstream rollers, then the web will be moved in a longitudinal direction without creating tension in the longitudinal direction. It is when the downstream rollers are moving at a higher speed than the upstream rollers that there is a resulting tension that tugs the web downstream in the longitudinal direction. Another way of moving a web in a longitudinal direction is to place the web atop a succession of moving belts, which all move at the same rate. Since all of the belts move at the same rate, the web atop these belts will not be placed under tension in the longitudinal direction.

Lines 8-15 on page 8 of the Examiner's Answer provide the following explanation:

Regarding appellant's argument that Weber et al. uses vacuum and Dobrin et al. uses tension, examiner is not taking Weber et al. wholesale into Dobrin et al., but rather using the concept of using multiple rolls acting with a single mating roll to reduce tension. This occurs whether the web is held on the roll by vacuum or by tension. Additionally, Weber et al. uses vacuum since the cutting step forms individual pieces of elastic which clearly cannot be held in place by tension since they are no longer part of a continuous web. When the elastic is still part of a continuous web, one in the art would appreciate that tension could be used instead.

To the above explanation, appellants reply that the problem with the use of Weber et al in the Final Action is that such use ignores the context of Weber et al from which the extracted teaching of Weber et al was drawn and ignores the fact that such context also must be considered to be presented to the person of ordinary skill. The

Final Office Action would have it that the prior art is a smorgasbord in which none of the individual offerings is related to any of the other offerings, and therefore the Office is free to pick and choose whatever is necessary to supply an element missing from a *prima facie* case. Moreover, the above explanation accepts as fact what the Office must prove, namely, that persons of ordinary skill regard using multiple rolls acting with a single mating roll to reduce tension in a web whether the web is held by vacuum on the edges or by longitudinal tension to prevent the web from sliding transversely during the process. In so doing, the Office is putting the cart before the horse, and the conclusion that the Examiner's Answer would have the Board reach is placed in severe doubt by the indisputable fact that the Dobrin et al inventors were aware of the Weber et al process, which apparently had been in use in their employer for many years before the Dobrin et al invention.

Lines 13-16 on page 9 of the Examiner's Answer state:

The statutory standard of obviousness involves the hypothetical person of ordinary skill in the art, not the actual inventors (or authors) of references used as evidence of obviousness. The KSR decision states that the combining of prior art techniques according to known methods to yield the predictable results is obvious.

While this statement expresses how the Courts have interpreted Section 103(a) of the Patent Code, Section 103(a) itself makes no reference to any "hypothetical" person of ordinary skill. Nor does Section 103(a) preclude evidence of what actual inventors or authors of references that are advanced as evidence of obviousness, actually do in real life. Furthermore, the KSR decision did not contain facts like are present here. Appellants merely are pointing out facts that support their contention of

patentability. The above protestations in the Examiner's Answer cannot justify the Board's ignoring of these facts, which are very pertinent to the real life determination of non-obviousness.

Moreover, 35 U.S.C. 103(a) does say that it is appellant's "**subject matter as a whole**" that must be determined to have been obvious, not individual elements nor the combination of a couple of individual elements. What the Examiner's Answer is doing here is taking each two elements in isolation from the rest and making a case that the combination of the two elements is obvious, and thereafter at the conclusion of this exercise, asserting as proven, the fact that all of these elements in the specific combination of appellant's claims would be deemed obvious to the person of ordinary skill. Appellants respectfully submit that this technique of the Examiner's Answer does not satisfy 35 U.S.C. §103(a)'s requirement to address appellants' "**subject matter as a whole**" is obvious to the person of ordinary skill.

Lines 8-16 on page 12 of the Examiner's Answer state:

Regarding appellant's argument that Boger et al. does not disclose use of a slot coat process to apply adhesive directly to a flexible sheet, the slot coater (20, col. 2, ll. 28-31) applies the adhesive directly to the flexible web. (Figure 1) While this is not a stretched web, it is a web which is part of a diaper, as are Dobrin et al. and Weber et al. The web of Dobrin et al. is a stretched web and the reference discloses adhesive can be applied to the stretched web (col. 21, ll. 24). Clearly then, one in the art would appreciate any problems associate with using adhesive on a non-woven porous web and how to account for them since the primary reference indicate adhesive can be used. (col. 21, ll. 24)

The above statement overlooks the flaw in this logic. The Examiner's Answer seeks to use Boger et al to supply a deficiency in Dobrin et al regarding use of a slot

coat process to apply adhesive. Thus, one must look to what Boger et al is using the slot coat process to apply adhesive to. Boger et al is not applying adhesive to the non-woven porous web that is in Dobrin et al. Thus, the fact that Dobrin et al says that adhesive can be applied to a non-woven porous web, does not mean that the person of ordinary skill would assume that such adhesive could be applied in a manner different from what Dobrin et al teaches. And Dobrin et al does not suggest using a slot coat process. Nor does Boger et al suggest using a slot coat process to apply adhesive to a non-woven porous web. So a linking step is missing in the logic employed here by the Examiner's Answer.

Lines 2-6 on page 9 of the Examiner's Answer explain:

Appellant's arguments are not commensurate is (sic) scope with the claims as appellant is arguing that the fins and grooves of Weber et al. fit hand in glove and touch along all surface while appellant's do not, but the claim only requires the fins to fit within the grooves which a hand in glove arrangement provides. Even the primary references shows (sic) fins fitting within grooves when corrugating the web. (Figure 2)

The flaw in the above explanation is that it ignores the limitations of appellants' claims that require "forming successive **nips** between the forming surface and the mating surfaces wherein the fins of the mating surfaces enter the grooves of the forming surfaces at separate locations on the forming surface;" and "feeding said first flexible sheet material into the successive **nips** while maintaining the position of said first flexible sheet material with respect to said forming surface;". Because the fins and grooves of Weber et al fit hand in glove and touch along all surfaces, they would not be used in a method like appellants' where there must be **nips**. If the fins fit hand in glove

With the grooves, then the web would be held fast and not being fed into the **nips**. Yet according to appellants' claims, the web must continue in the longitudinal direction while being fed into the **nips**. In the Weber et al configuration, the web is grabbed between the fins and grooves. Appellants were referencing the hand in glove analogy to bring out this difference that would preclude the person of ordinary skill from looking to Weber et al to supply the noted deficiency in Dobrin et al.

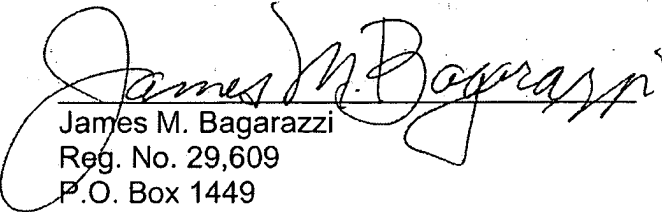
Conclusion

Appellants respectfully submit that claims 1-20 are patentable over the art, the rejections should be reversed, and claims 1-20 should be allowed to issue in a patent.

Respectfully submitted,

DORITY & MANNING, P.A.

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